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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,468	07/10/2000	Morten Sloth Weidner	04590461P	9245

2292 7590 11/19/2002

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EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 11/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/613,468

Applicant(s)

WEIDNER, MORTEN SLOTH

Examiner

Sharmila S. Gollamudi

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 17, 18 and 26-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 17, 18 and 26-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt of Amendment C received on August 22, 2002 is acknowledged.

Claims 1-9, 17-18, and 26-34 are included in the prosecution of this application.

Response to Amendment

The amendment clarifying the amount of butyrospermum-triterpene is sufficient to overcome the Zabotto et al reference. The Declaration filed August 22, 2002 is effective to demonstrate Zabotto et al no longer anticipates instant claims.

Claim Rejections - 35 USC § 103

Rejection of claims 1-5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laur et al (5679393) is maintained. New claim 31 is also rejected to under 35 U.S.C. 103(a).

Response to Arguments

Applicant argues that Laur et al contains a mixture of cold-soluble fractions and hot-soluble fractions, which contributes to the valuable properties in the fields of cosmetology, pharmacy, or medicine.

Applicant's arguments have been fully considered but they are not persuasive. The examiner points out that the instant claim language does not exclude other components in the composition. Further, it is the examiner's position that the unsaponifiable material of Laur et al inherently contains the recited components lupeol, stigmasterol, amyirin, and butyrospermol (parkeol). A mere recitation of inherent components in a product does not patentably distinguish instant claims over the prior art unless applicant shows the prior art does not possess these inherent features.

*Note for claim 31, the limitation "upto" recites the lower limit of the claim in which it depends from; therefore Laur reads on instant claim.

Rejection of claims 17-18 under 35 U.S.C. 103(a) as being unpatentable over Laur et al cited above, in view of WO 9922706 is maintained.

Response to Arguments

Applicant argues that Laur et al contains a mixture of cold-soluble fractions and hot-soluble fractions, which contributes to the valuable properties in the fields of cosmetology, pharmacy, or medicine. Applicant argues that WO teaches extracts from flowers of the *Butyrospermum parkii*. It is argued that the inflammation taught by WO relates to different inflammatory conditions than that of instant invention.

Applicant's arguments have been fully considered but they are not persuasive. Applicant's arguments regarding Laur et al have been addressed above. In regards to WO, the examiner points to the abstract, which teaches the use of a plant extract from the shea tree or *Butyrospermum parkii* tree to treat inflammation. The examiner points out that the instant claims recite inflammation in generic terms and do not specify the type of inflammation being treated. Therefore, there is reasonable expectation of success since Laur et al teaches the composition has anti-inflammatory activity on column 5, line 24 and WO teaches extract of shea treat inflammation.

New Rejections in Light of Amendments

Claim Objections

Claims 26-30 and 32-33 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous

claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The recited method claims depend on composition claims, since the scope of the claims are different and the method claims do not further limit the composition claims.

Claim 34 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether the composition contains 2-30% each of germanicol, dammaradienol, 24-methylene-dammarenol, and/or parkeol or 2-30% of germanicol. Further, it is unclear whether the listed actives are all included in the composition or the actives are part of a Markush group.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laur et al (5679393) in view of SU 1181171.

As set forth, Laur et al a composition with shea butter fractions containing triterpene alcohols and sterols, which has anti-inflammatory activity (col. 111, lines 40-51).

Laur et al do not teach *Calendula officinalis* in the composition.

SU 1181171 teaches the anti-inflammatory properties of the marigold plant and its extract (Note abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add marigold extract in Laur et al's composition. One would be motivated to do so with a reasonable expectation of at least an additive if not a synergistic effect in the composition since Laur teaches the anti-inflammatory activity of the composition and SU 1181171 teaches the anti-inflammatory properties of marigold.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

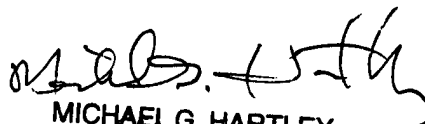
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 703-305-2147. The examiner can normally be reached on M-F (7:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 709-3080196.

SSG


November 18, 2002


MICHAEL G. HARTLEY
PRIMARY EXAMINER